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In re Application of
Gary Carlton Johnson
Serial No: 10/021,656
Filed: December 12, 2001
For: JOHNSON-POSTIVE ACTION CONTINUOUS
TRACTION (P.A.C.T.)
VEHICLE DIFFERENTIAL

: DECISION ON PETITION
: TO WITHDRAW THE
: FINALITY OF OFFICE
: ACTION

This is a decision on the petition under 37 CFR 1.181 filed May 22, 2006 to revoke the final action mailed December 6, 2005 and the Advisory Action mailed March 22, 2006, and enter the amendment filed March 2, 2006.

The petition is **Granted-In-Part**.

A review of the application file history reveals that applicant filed an amendment May 23, 2005 in response to a Notice of Noncompliant Amendment mailed May 4, 2005. An Office action was mailed June 28, 2005 in which the examiner objected under 35 USC 132 to the amendment of May 23, 2005 as containing new matter and rejected the claims under 35 USC 112 second paragraph. Applicant filed an amendment July 21, 2005 amending the claims and providing arguments. A Notice of Non-Compliant Amendment was mailed August 4, 2005 and in response applicant filed an amendment August 15, 2005. An Office action was mailed October 24, 2005 in which the examiner again objected under 35 USC 132 to the amendment filed May 23, 2005 as containing new matter, objected to the specification under 37 CFR 1.75(d)(1) as failing to provide proper antecedent basis for claimed subject matter and rejected claims 15 and 16 under 35 USC 112 first paragraph. Applicant filed a response November 17, 2005 providing arguments concerning the October 24, 2005 Office action. On December 6, 2005 a final rejection Office action was mailed in which the examiner again objected under 35 USC 132 to the amendment filed May 23, 2005 as containing new matter, again objected to the specification under 37 CFR 1.75(d)(1) as failing to provide proper antecedent basis for claimed subject matter again rejected claims 15 and 16 under 35 USC 112 first paragraph and suggested an allowable claim for applicant to file. Applicant filed an amendment March 2, 2006. An Advisory Action was mailed March 22, 2006 refusing entry of the March 2, 2006 amendment because it raised new issues that would require further consideration and/or search, raised the issue of new matter and did not place the application in better form for appeal.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97 (c) with the fee set forth in 37 CFR 1.17(p). See MPEP 706.07(a). A review of the Office action of October 24, 2005 and the final rejection of December 6, 2005 shows that the examiner did not introduce a new ground of rejection in the final rejection. The rejections were the same as those set forth in the October 24, 2005 Office action. Therefore, making the December 6, 2005 Office action final was proper.


The examiner refused entry of the March 2, 2006 amendment after final because it raised new issues that would require further consideration and/or search, raised the issue of new matter and did not place the application in better form for appeal. The drawings filed March 2, 2006 still have the added support stock protruding from axial sides of the differential case that was objected to in the December 6, 2005 final rejection as new matter and still should not be entered. The amended sections of the specification that were submitted March 2, 2006 remove the new matter that the examiner objected to in those sections. Furthermore, applicant submitted a statement that the sections of the specification he was amending contained no new matter. MPEP 714.13 states "However, if the proposed amendment raises the issue of new matter, the examiner should identify the subject matter that would constitute new matter." The examiner did not identify in the March 22, 2006 Advisory Action what constituted new matter in the proposed amendments to the specification and applicant stated it contained no new matter. Therefore the proposed amendments to the specification should have been entered. The March 2, 2006 amendment canceled all previous claims and added two new claims 17 and 18. A review of claims 17 and 18 shows that they do not include the features pointed out as lacking support in the original application in the 35 USC 112 first paragraph rejection of the December 6, 2005 final rejection. MPEP 714.13 states "If the proposed amendment presents new issues requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues that would require further consideration and/or search." The examiner stated in the March 22, 2006 Advisory Action that new claims 17 and 18 would require further consideration and search but did not provide an explanation as to the reasons. Since both the amendments to the specification and the new claims appear to eliminate the specific objections the examiner had with the specification and the previous claims and because the examiner provided no explanation of what the new matter issues are or why the amendment would require further consideration and search, the amendments to both the specification and claims appear to possibly avoid the objections and rejections set forth in the December 6, 2006 final rejection and place the case in better condition for appeal or allowance. Therefore the March 2, 2006 amendments to the specification and claims should have been entered.

The application will be promptly returned to the examiner for consideration of the amendment of March 2, 2006.

Telephone inquiries relative to this decision should be directed to Supervisory Patent Examiner Charles Marmor at (571) 272-7095.

SUMMARY: The petition is **GRANTED-IN-PART**. The December 6, 2006 final rejection will not be revoked. The replacement drawing of March 2, 2006 will not be entered. The amendments to the specification and claims filed March 2, 2006 will be entered.


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